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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,360	06/08/2001	Tung-Liang Li	PUSA210516	1522
23595	7590	02/23/2005	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			CHAU, COREY P	
			ART UNIT	PAPER NUMBER
			2644	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,360

Applicant(s)

LI, TUNG-LIANG

Examiner

Corey P Chau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 4 recites the limitation "the word file" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 2 is rejected under 35 U.S.C. 102(a) as being anticipated by Voice-Trek V-10 Digital Voice Recorder from Olympus Press Release dated May 31, 2001 (hereafter as Olympus). Note: The V-10 contains the same technology as the DW-90; therefore see DW-90 for further details.

6. Regarding Claim 2, Olympus discloses a digital recording microphone (page 1, identification of parts) comprises: a rod (page 1, identification of part figures), a head disposed on the rod (1), a socket disposed in a bottom of the rod (23), and a digital

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recorder disposed on the bottom of the rod (i.e. PC, wherein recording on a PC with the recorder as the microphone)(page 6, column 2), the digital recorder having a display (i.e. monitor)(page 5, column 2), a pause button (i.e. pause button)(page 6, column 2), a fast-selection button (i.e. clicking on desired sound file from sound file list)(page 6, column 1), a hold button (i.e. it is inherent that the computer has a keyboard, wherein the keyboard has a Num Lock key, a Caps Lock key, and a Scroll Lock key), a clear-away button (i.e. it is inherent that the PC has a delete button to delete files, if the PC was utilized as the recorder), a play button (i.e. PLAY button), a repeat button (i.e. Rewind button), a record button (i.e. Record button), a fast-forward button (i.e. Fast Forward button), a recording-mode button (i.e. Recording window button), a memory device (i.e. to perform direct recording, 20MB or more of the hard-disk space is necessary to assure stable performance of the PC)(page 6, column 2), a plurality of cells (i.e. components in the PC), a lower connector (i.e. it is inherent that the computer has connector to connect to other devices or to a power supply), and an upper connector (page 5, column 2), the upper connector engaging with the socket (i.e. PC's (USB) port engaging with the PC (USB) terminal 23), and a plug engaging with the lower connector (i.e. it is inherent that the computer has connector to connect to other devices or to a power supply), wherein the digital recorder converts a voice into a digital file (i.e. the recorder has three folders: A, B, and S, wherein each recorded message stored in a folder is saved as a Wave file)(page 2, column 2),

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olympus.

9. Regarding Claim 1, Olympus discloses a digital recording microphone (page 1, identification of parts) comprises: a hollow rod (page 1, identification of part figures), a head disposed on the hollow rod (1), a connector disposed in a bottom of the hollow rod (23), a digital recorder disposed in the hollow rod (i.e. it is inherent that the digital voice recorder comprise a digital recorder is disposed in the hollow rod), and a cover disposed on the hollow rod to cover the digital recorder (17)(i.e. a cover could be the battery cover which does cover the digital recorder and the cover can be the housing for the digital recorder, which does cover the digital recorder), the hollow rod having a speaker (16), an earphone jack (9); and a personal computer connecting jack (23), the digital recorder having a display (3), a pause button (i.e. to pause, press the REC button during recording or press play button during playback)(page 3, column 1), a fast-selection button (19), a hold button (4), a play button (18), a clear-away button (8), a repeat button (20), a record button (7), a fast-forward button (i.e. fast playback, press and hold the PLAY button for 1 second or longer while playing a file), a recording-mode button (13), a memory device (i.e. the digital voice recorder comprise 3 folders to store

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up to 100 files per folder)(page 2, column 2), and a plurality of cells (i.e. batteries)(page 2, column 1), wherein the digital recorder converts a voice into a digital file (i.e. the recorder has three folders: A, B, and S, wherein each recorded message stored in a folder is saved as a Wave file)(page 2, column 2). Olympus does not expressly disclose a line-in jack. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a line-in jack, in order the device to receive external audio signals.

10. Regarding Claim 3, Olympus as modified discloses the digital recorder is hidden in the hollow rod, and the cover (17) is flush with a surface of the hollow rod (page 1, column 2; page 2, column 1).

11. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Olympus in view of U.S. Patent Application Publication No. 2002/0143533 to Lucas et al. (hereafter as Lucas)

12. Regarding Claim 4, Olympus as modified does not expressly disclose the digital recorder converts the voice into a word file directly. However it would have been obvious to one having ordinary skill in the art to provide the digital recorder that converts the voice into a word file directly in order to eliminate the need for traditional read-and-type or listen-and-type transcription, as taught by Lucas (page 1, paragraph 0005). It is well known in the art to generated and editable text file from a user's dictation using voice recognition technology, therefore a digital recorder provided with a voice recognition system would convert the voice into a word file directly.

Response to Arguments

13. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey P Chau whose telephone number is (703)305-0683. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Sinh can be reached on (703)305-4040. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 18, 2005



XU MEI
PRIMARY EXAMINER